REMARKS

Claims 1-36 are pending in the application. In the office action, claim 36 is objected to because of an allegedly undefined limitation within the context of the claim. Claims 29-33 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Claims 1-10, 12-27, and 29-36 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S Patent No. 5,652,201 to Papay. Claims 1, 11, and 28 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,048,826 to Ikeda. The rejections are respectfully traversed and should be withdrawn. Reconsideration and allowance of claims 1-36 are respectfully requested in view of the following remarks.

A. The Objection to Claim 36

Claim 36 is objected to because of an allegedly undefined limitation within the context of the claim. Accordingly, claim 36 is amended to define the limitation within the context of the claim. Support for the amendment may be found throughout the specification as originally filed, for instance in Example 2 at page 11, line 27 through page 13, line 2. The applicants assert that no new matter is entered into the case by this amendment. Reconsideration and allowance of claim 36 by the examiner is hereby respectfully requested.

B. The Rejection of Claims 29-33 for Non-enablement is Untenable.

Claims 29-33 are directed to methods for improving specific properties of a power transmission fluid. A power transmission fluid is understood by those skilled in the art as containing components necessary to provide the intended function. Page 10 of the specification identifies the components that may be contained in a power transmission fluid, one of which is a non-dispersant viscosity index improver. It is further demonstrated within the specification that the addition of a non-dispersant viscosity index improver has the effect of improving certain other properties of a power transmission fluid. These improved properties are improved anti-shudder performance, improved

torque performance, and improved elastomeric compatibility. Elastomeric compatibility is further explained as an improvement in the promotion of the swelling of elastomeric seal and gasket components.

According to the office action, claims 29-33 contain subject matter which is not described in the specification in such a way as to enable one skilled in the art to make or use the invention. Applicants have demonstrated in the examples on pages 10-13 of the application that use of the claimed additive does in fact increase the anti-shudder capability, improve the torque performance, and improve the elastomeric compatibility of the power transmission fluid as defined in the specification. Accordingly, use of the prescribed additive composition according to the methods claimed provides the claimed improvements. Claims 29-31 as presently amended are now sufficiently enabled. The applicants respectfully disagree with the examiner that claims 29 and 30 are "identical" and should be combined. It is clearly stated within the specification on page 11, paragraph 3 that torque performance is indicative of shudder performance; the two are entirely different properties. Thus, individual claims regarding improvements in each of the aforementioned properties are supported.

Reconsideration and allowance of the amended claims 29-31 by the examiner is hereby respectfully requested. The applicants assert that no new matter is entered into the case by the aforementioned amendments to the claims. Claims 32 and 33 depend from claim 31, and should therefore be considered for allowance in view of the amendment to claim 31. Reconsideration and withdrawal of the rejection are respectfully requested.

C. Claims 1-10, 12-27, and 29-36 are Patentably Distinguished Over Papay (U.S. 5,562,201)

In the rejection of claims 1-10, 12-27, and 29-36, the '201 patent to Papay et al. is cited. The office action states that in column 59 lines 17-49 (Example XXI), Papay discloses a lubricant composition comprising a major amount (82.230%) of a base oil and a minor amount of an additive composition which includes 5.300% by weight of a

polymethacrylate viscosity index improver. The office action further states that this composition meets the compositional limitations of present claims 1-5, and that it must therefore provide the anti-shudder properties of present claims 1 and 9. However, nothing in Papay discloses, teaches, or suggests that the polymethacrylate viscosity index improver is a non-dispersant viscosity index improver.

Papay discloses lubricating oil compositions having a metal containing detergent and an oil soluble boron-free dispersant. The composition of Papay is reported to exhibit good elastomeric compatibility in promoting seal swell of gaskets and seals.

The present claims relate to a power transmission fluid and to an additive combination that effectively improves the anti-shudder capability, torque performance, and elastomeric compatibility of a transmission fluid. The presently claimed fluid contains a base oil and a transmission fluid additive composition that includes a non-dispersant viscosity index improver.

Papay discloses the use of a dispersant viscosity index improver. (See Column 46, lines 44-50). Further, the Acryloid® polymethacrylate used in the examples is a dispersant polymethacrylate. In the attached documents it is shown that Acryloid, which is now available under the tradename Viscoplex®, is a dispersant polymethacrylate, containing polar amine-derived substituents.

The present claims specifically include non-dispersant polymethacrylate viscosity index improvers. There is nothing in Papay that teaches, suggests, or discloses the desirability of use of a non-dispersant viscosity index improver as a method to improve anti-shudder capabilities, improve torque performance, and improve the elastomeric compatibility of a lubricating oil composition.

Accordingly, Papay is manifestly deficient in teaching, suggesting, or disclosing all of the elements of the presently claimed invention. Since Papay fails to disclose all of the elements of the presently claimed invention, reconsideration and allowance of claims 1-10, 12-27, and 29-36 are respectfully requested.

D. Claims 1, 11, and 28 Are Patentably Distinguished Over Ikeda (U.S. 6,048,826)

In the rejection of claims 1, 11, and 28, the '826 patent to Ikeda et al. is cited. Ikeda fails to teach, suggest, or disclose transmission fluids or methods to improve the anti-shudder capability, torque performance, and elastomeric compatibility of transmission fluids comprising the addition of non-dispersant viscosity index improvers. Ikeda is primarily directed to a lubricating oil composition comprising a major amount of a base oil and a minor amount of an additive composition comprising A) a dithiocarbamate compound and B) a condensate of a branched chain fatty acid having from 8-30 carbon atoms and an amine, and optionally C) an amine-type antioxidant.

While the examples given in Ikeda do include a polymethacrylate additive, there is no disclosure or teaching to use a non-dispersant type polymethacrylate. No advantage is stated in the use of the polymethacrylate, other than its function as a viscosity index improver. One skilled in the art would have no indication from reading this patent that a non-dispersant polymethacrylate would have any advantage over a dispersant polymethacrylate in reducing shudder capability.

Since Ikeda fails to specifically include a non-dispersant viscosity index improver, it does not meet the compositional limitations of our claims 1, 11, and 28.

In fact, Ikeda clearly suggests that the required components for shudder reduction are A) a dithiocarbamate compound and B) a condensate of a branched chain fatty acid having from 8-30 carbon atoms and an amine, and optionally C) an amine-type antioxidant. While viscosity index improvers may be included in the additive composition, there is no specific teaching in Ikeda that would lead one skilled in the art to select the applicants' non-dispersant viscosity index improver for any purpose, much less for the purpose of improving the shudder reduction of a transmission fluid. Accordingly, Ikeda is manifestly deficient in teaching, suggesting, or disclosing all of the elements of the claimed invention and the benefits therefor. Reconsideration and allowance of claims 1, 11, and 28 are respectfully requested.

CONCLUSION

Applicants assert that the claims of the present application are definite, enabled, and patentably defined over the references made of record and not relied upon for the same reasons as given above. Applicants respectfully submit that a full and complete response to the office action is provided herein, and that the application is now fully in condition for allowance. Action in accordance therewith is respectfully requested.

FEES

The undersigned believes that there are no fees associated with this filing. However, if the calculations are incorrect, the Commissioner is hereby authorized to charge any deficiencies in fees or credit any overpayment associated with this communication to Deposit Account No. 12-2355. Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 12-2355.

Respectfully submitted,

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